

REMARKS

Please note that the USPTO cover page indicates that Applicant's first name is "Tomas", please correct this typographical error to his actual first name which is "Thomas".

In the Office action dated November 30, 2005, on the cover page the Examiner indicated that the drawings were rejected but did not indicate what drawings or which portions of what drawings were rejected in the Examiner's response. No draftsperson's review was included. Applicant is presuming that Figure 2 which lacked the clarity of the remaining figures was at issue and herewith includes a formal drawing Figure 2 with this response. If the Examiner deems that changes, improvements, etc. to any remaining figures are necessary, Applicant respectfully requests direction on which depicted elements of what drawings require editing.

Also, in the Office action dated November 30, 2005, the Examiner objected to the informality of the line numbers being too close to the claim numbers. Included herewith is a reprinted original and unchanged copy of the claims in the original format with the line numbers moved slightly to the left, away from the claim numbers.

The Examiner rejected claim 9 pursuant to 35 U.S.C. §112 as indefinite. Claim 9 has been deleted.

In the Office action dated November 30, 2005, the Examiner rejected claims 1 - 5, 9, 14, & 16 pursuant to 35 U.S.C. §102(e) as anticipated by *Morrison et al.*, U.S. # 6,776,562. The Examiner further rejected claims 6 - 8 and 12 - 13 pursuant to 35 U.S.C. §103(a) as obvious in light of *Morrison et al.* in view of *Winslow*, U.S. #2,910,895, claims 10 - 11 as obvious in light of *Morrison et al.* in view of *Shulters et al.*, U.S. # 2,883,891, claim 15 as obvious solely in light of *Morrison et al.*, and claims 17 & 18 in light of *Morrison et al.* in view of *Winslow* and further in view of *Shulters et al.*

Applicant has amended all independent claims 1, 16, & 17 and further amended dependent claims 2, 4, 6 - 8, & 15 and cancelled claims 3, 5, & 9 and believes the aforesaid together with the corresponding dependent claims comply with the requirements of 35 U.S.C. §102(e) & §103(a). Applicant respectfully traverses the Examiner's §102(e) and §103(a) rejections. Applicant further states that no new matter has been added to the present art Application.

Regarding the aforesaid §102(e) rejection of Applicant's amended claims 1 - 4, 14, & 16 including the corresponding dependent claims, *Morrison et al.* describes a power feed drill utilizing a double acting actuation cylinder **36** with a hydraulic cylinder **58** which acts as a feed rate (not force) controller or dampener. It is important to note that the art of *Morrison et al.* only controls feed rate and not feed force. Nowhere in *Morrison et al.* is the issue of drill force upon the work material addressed. In order to control drill or feed force with a cylinder such as in *Morrison et al.* a pressure regulator is required. Nowhere in *Morrison et al.* or *Winslow* is the term "regulator" even present.

In the afore described office action, the Examiner referred to the Clippard valve 72 as a regulator. Included herewith as Exhibit A, is a datasheet for the Clippard E4-1PS0-000 valve as described in *Morrison et al.* at Col. 4, Lines 63 - 67. The aforesaid datasheet may be found online at http://www.poweraire.com/pdf/other/clippard/Eagle_Valves.pdf. Review of the Exhibit A datasheet reveals that the valve of *Morrison et al.* is not a regulator but simply an air piloted valve which does not control the applied pressure. In fact at Col. 5, Lines 38 - 42, *Morrison et al.* states:

“Valve 72 is biased in a first position by an internal biasing spring (not shown), allowing the **constant pressure** of air provided through first inlet line 82 to travel through valve 72 out first outlet drive line 90 to rear portion 36b of double acting air cylinder 36.” (emphasis added)

Morrison et al. does not describe or provide a motivation, suggestion, or teaching of a variable pressure or regulation system to control force. Instead, *Morrison et al.* injects full air pressure into his cylinder and controls the rate of retraction with his hydraulic cylinder 58. (Col. 4, Lines 58 - 61) The technique of *Morrison et al.* and *Winslow* applies the full force available to the work which, as understood within the mechanical arts, may cause damage to the drill bit or form an irregular drill hole. Applicant’s art allows the user to control the force of the drill upon the work material, thereby allowing the user to apply the proper force for the type of work material and bit. (i.e. metals, glass, concrete, etc. all require different drill application forces in order that the drill bit is not destroyed and the hole is uniformly drilled.) Variation of force upon the work is even more significant if the drill bit is slightly dulled. A dulled drill bit cannot be fed with same the force as a sharpened drill bit. The aforesaid distinctions are not described or even alluded to in *Morrison et al.* and *Winslow*.

Included herewith as Exhibit B is a datasheet from the Clippard company which describes Applicant’s MAR-1CP regulator which is described in Applicant’s specification. This datasheet may be found online at http://clippard.com/store/display_details.asp?sku=MAR-1CP. The datasheet specifically states under the “notes” section that it provides “increased pressure proportionally as plunger is depressed.” If *Morrison et al.* intended to utilize a variable regulator, most likely the inventors of *Morrison et al.*, if available at the time of the invention, would have seen Applicant’s specified variable regulator in the Clippard catalog or website from which *Morrison et al.* was specifying parts and stated such or used such in the design. Nevertheless, *Morrison et al.* is silent about the regulator issue.

The uniquely small dimensions of approximately 2.3 x .7 inches of this linear controlled regulator have, until recently, been unavailable in a variable pressure regulator. Prior art regulators have been too bulky to mount with the drill press and required a screw adjustment for pressure control instead of a linear lever control, all of which are impractical for real time user interactive drill press use. This may be the reason why *Morrison et al.* and *Winslow* went to such great and contorted extremes to dampen the unregulated force of the pneumatic supply when supplied through a valve.

The distinction between a valve and a regulator is significant within the mechanical pneumatic arts. The elements are not synonymous or equivalent. That is, they are distinct in construction,

operation, and use. One of ordinary skill in the art would not state interchangeably that a valve is a regulator. For examination purposes the aforesaid distinction may seem as a semantic play, yet a similar issue was presented in U.S. Patent #6,220,581 issued to the present Applicant *Mueller* on April 24, 2001. The distinction presented was between a "gas spring" (**not an air spring**) and a piston/cylinder arrangement. The U.S. Board of Patent Appeals in *Ex parte Thomas L. Mueller*, Appeal No. 2000-0565, relating to Application No. 08/539,840, (Bd. Pat. App. & Inter. 2000) recognized the distinction within the mechanical arts. In *Mueller*, the examiner made an equivalency between a "gas spring" (*Mueller*) and a "gas piston/cylinder" (*Carroll*) for §102 anticipation purposes. The Applicant therein argued that although both were linearly actuating elements, they are not equivalent as understood by one of ordinary skill in the mechanical arts and thereby could not be used interchangeably for §102 anticipation purposes. That is, a "gas spring" is a term of art which has a uniquely understood meaning by those of ordinary skill in the art. The Administrative Court agreed with the Applicant therein and reversed the examiner. The Court stated "while the adjustment assembly of *Carroll* does comprise a gas cylinder, the trapped air cylinder disclosed therein is not a "gas spring" as that term would have been understood by one of ordinary skill in the art for the reasons stated by the appellant." (Page 6, *Ex parte Thomas L. Mueller*)

As relating to the aforesaid, Applicant is referring to a specific type of mechanical element when the term "regulator" is utilized and not a valve. This specific referral excludes a valve arrangement as in *Morrison et al.* and *Winslow*. Nowhere in *Morrison et al.* and *Winslow* is reference made to a regulator or substitution of a valve for a regulator.

The distinctions between *Morrison et al.* and *Winslow* are also furthered by the fact that neither uses a spring mechanism for retraction of the drill bit from the work material. Both *Morrison et al.* and *Winslow* utilize a compressed air piston and cylinder for retraction. This further requires use of a dampening means (i.e. shock absorption means) to control the retraction velocity. (callout 58 of *Morrison et al.* and callout 73 of *Winslow*) Applicant's art with his variable thumb controlled regulator allows easy and controlled retraction without the requirement of a shock absorber like dampening system. It is worth noting as relating to *Shulters et al.*, Applicant places, and states in his claims, his springs behind the drill motor and mount which minimizes interference with the work operation.

It is worth noting that *Morrison et al.* and *Winslow* are not actually drill presses but simply power fed hand drills. Applicant's art is an actual adjustable drill press which mounts to the work and provides the force control and material thickness adjustment desired between the press, work material, and bit. Nowhere in *Morrison et al.* and *Winslow* is it described that the work material feeds toward the drill bit or is adjustable to accommodate various work material thicknesses therebetween as in Applicant's claims 4 & 16. *Morrison et al.* and *Winslow* do not extend the pneumatic actuator shaft toward the drill motor as described and limited in Applicant's claim 16.

Under 35 U.S.C. §102, anticipation requires that each and every element of the claimed invention be disclosed in the prior art. In addition, the prior art reference must be enabling, thus placing the allegedly disclosed matter in the possession of the public. *Akzo N.V. v. U.S. International*

Trade Commission, 1 USPQ 2d 1241, 1245 (Fed. Cir. 1986), *cert. denied*, 482 U.S. 909 (1987). As aforesaid, *Morrison et al.* is silent about the regulation, retraction, and work feed elements of Applicant's amended claims. Failure of *Morrison et al.* to place any one of the aforesaid does not satisfy the disclosure requirements of Akzo N.V.

Further relating to *Morrison et al.*, invalidity for anticipation requires that all of the elements and limitations of the claim are found within a single prior art reference. There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. Scripps Clinic & Research Foundation v. Genentech Inc., 18 USPQ 2d 1001, 1010 (Fed. Cir. 1991). The prior art reference of *Morrison et al.* does not disclose the aforesaid unique features, function, or result of Applicant. The aforesaid is further reinforced in Motorola, Inc. v. Interdigital Tech. Corp., 43 USPQ 2d 1481, 1490 (Fed. Cir. 1997) as stated, "for a prior art reference to anticipate a claim, the reference must disclose each and every element of the claim with sufficient clarity to prove its existence in the prior art." Motorola, Inc. further states, "although this disclosure requirement presupposes the knowledge of one skilled in the art of the claimed invention, that presumed knowledge does not grant a license to read into the prior art reference teachings that are not there." As aforesaid, each of the unique afore described elements of Applicant is not found in *Morrison et al.*

Regarding the aforesaid §103(a) rejection of Applicant's claims 6 - 8 and 12 - 13 relative to *Morrison et al.* in view of *Winslow*, Applicant incorporates by reference the aforesaid distinctions stated with respect to the §102(e) rejections. *Winslow* teaches a power fed hand drill and not a drill press which does not control bit force onto the work material. Instead, *Winslow* discloses an oil dampening system which dampens the full force pneumatic air cylinder velocity of movement. (Col. 13, Lines 11 - 17) Also, *Winslow* is clearly not a drill press whereby work material may be placed between portions of a frame. Instead, *Winslow* requires that his device be attached to the work.

It is agreed that *Winslow* describes a suction cup form and a venturi to evacuate the suction cup. If that elemental combination were all that Applicant claimed, said §103(a) rejection would be proper. As aforesaid, Applicant's unique force regulated feed, full adjustable press arrangement, and mounting method and placement uniquely identify Applicant's art apart from the disclosure of *Winslow*.

Regarding Applicant's claims 12, 13, & 18, the Examiner described the bead **504** of *Winslow* as an equivalent to Applicant's mating plate **72**. The bead **504** of *Winslow* is described in Col. 18, Lines 36 - 48 as being placed around the "periphery" to "establish an efficient air tight seal". The bead **504** is not a metallic element placed in the suction cup to rigidly stabilize the device but is instead a soft "silicone putty material" which is used to seal the periphery when adhering to relatively rough surfaces such as concrete, brick or plaster surfaces." (Col. 18, Lines 29 - 32) Applicant's mating plate **72** has nothing to do with sealing but instead is utilized to mate with the surface on which Applicant's suction cup is mounted in order to provide a solid and stable base when a suction is achieved. Applicant's mating plate **72** is described as a metallic and incompressible plate which when compressed onto an equivalently shaped surface minimizes the wobbling or tilting of

Applicant's press. If Applicant's plate was a soft "silicone putty material" it would not function as described in Applicant's specification or claims to provide the stability required and claimed. None of the references cited disclose, describe, or suggest Applicant's mating plate 72 or its beneficial use.

Regarding the Examiner's rejection of claim 15 as relating to thumb force control, *Morrison et al.* need not address the issue since *Morrison et al.* provides a constant feed velocity once the drill is turned on. That is, if the drill of *Morrison et al.* is turned on, feed begins at a constant rate. If said rate is constant, variation is not required. If *Morrison et al.* were concerned about bit force, he would, by necessity, have a separate control for such. That is, by its very nature to control force while having the drill controllable, it must be a separate control. A constant velocity feed does not require this separate control.

As relating to *Shulters et al.* and claims 17 & 18, again it is important that Applicant places, and states in his claims, that his springs are located behind the drill motor and mount which minimizes interference with the work operation. *Shulters et al.* is again only a rate of feed control apparatus. (Col. 1, Line 11) *Shulters et al.* is silent about force control.

None of the references cited, either individually or collectively, have all of the unique elements of Applicant's amended claims as presented herein, nor do they provide a motivation, suggestion, or teaching of the desirability of making the specific combination that was made by Applicant. Regarding the aforesaid §103(a) rejections, the Federal Circuit now uses the suggestion test to assess obviousness rejections. In the case of *In re Kotzab*, 55 USPQ2d 1313 (Fed. Cir. 2000), the Federal Circuit stated that "to establish obviousness based on a combination of elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the **specific** combination that was made by the applicant." (the term "*specific*" is emphasized) The cited references do not provide a motivation, suggestion, or teaching of the desirability of providing the unique force control, suction holding elements and means, pressure regulation, thumb force control, spring placement, or full drill press combination of Applicant. The aforesaid is further reinforced in *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 56 USPQ 2d 1456, 1459 (Fed. Cir. 2000) citing *C.R. Bard, Inc. v. M3 Sys. Inc.*, 157 F.3d 1340, 1352, 48 USPQ 2d 1225, 1232 (Fed. Cir. 1998) which states as relating to obviousness, "the first requirement is that a showing of a suggestion, teaching, or motivation to combine the prior art references is an "essential evidentiary component of an obviousness holding."".

The aforesaid motivating suggestion must also be explicit. *Winner International Royalty Corp. v. Wang* 48 USPQ2d 1139, (D.C.D.C. 1998). The fact that prior art "may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 922 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992). Again, as aforesaid and without suggestion by the Examiner, *Morrison et al.*, *Winslow*, or *Shulters et al.* do not provide a motivation, suggestion, or teaching of the desirability of Applicant's art as described in his amended claims. That is, the aforesaid are bereft of suggestion on force control, regulators, convenient actuation of regulators, spring placement, mating plates, base plate adjustment, and Applicant's other distinctive elements stated.

In view of the foregoing, the independent claims along with the corresponding dependent claims are herewith submitted as patentable. Accordingly, favorable reconsideration and allowance of this application is requested.

Respectfully submitted,



Kevin L. Klug, Reg. No. 38756
Attorney for Applicant
11237 Concord Village Ave.
St. Louis, MO 63123-6903
(314) 849-2273

CERTIFICATE OF MAILING

I certify that the foregoing **AMENDMENT A** is being deposited with the United States Postal Service as FIRST CLASS MAIL US, postage prepaid, in an envelope addressed to: Commissioner of Patents, Mail Stop Fee Amendment, P.O. Box 1450, Alexandria, VA 22313-1450, on February 22, 2006.



Kevin L. Klug